

### **REMARKS/ARGUMENTS**

Claims 1-4, 7-8, 11, 12-15 and 20-26 have been amended. Claim 6 has been canceled. New claim 32 has been added. Claims 1-5 and 7-32 remain in this application.

#### ***Claim Rejections***

#### **35 U.S.C. §102(b)**

The rejection of claims 1-6, 8, 10-16, 18-27, 29, and 31 under 35 U.S.C. §102(b) as being anticipated by US Patent No. 5,935,127 to Border ("Border") is respectfully traversed. Independent claim 1 is directed to an intramedullary nail that comprises a body having a continuous edge defining an aperture therethrough. The aperture includes a first portion and two cylindrical end portions. The first portion is defined by opposed straight parts of the continuous edge and the cylindrical portions are defined by curved parts of the continuous edge. The widths of the cylindrical portions of the aperture are greater than the distance between the opposed straight parts of the continuous edge.

It is the Applicant's belief that Border does not disclose such a nail. In the office action, it appears that the Examiner is interpreting elements 17 and 22 in Border to comprise portions of an aperture. However, elements 17 and 22 are not defined by parts of a continuous edge. For at least this reason, claim 1 and its dependents are believed to be allowable over Border.

Independent claim 11 also includes the limitation that an edge defines an aperture in the intramedullary nail. The edge is spaced from the two ends of the body and includes substantially parallel parts defining a first portion of the aperture sized and shaped to cooperate with said first fastener to provide dynamic fixation. The edge includes a second curved part extending from and connected to the first substantially parallel parts. The curved parts of the edge define a curved part of the aperture that is sized and shaped to cooperate with said second fastener to provide either static fixation or dynamic fixation. The curved portion of the aperture has a width greater than the

distance between the substantially parallel parts of the edge defining the first portion of the aperture. Border does not disclose such an aperture. Therefore, claim 11 and its dependents are believed to be allowable over Border.

Independent claim 21 is a method claim and includes the limitation that an edge defines an aperture through the body of the intramedullary nail. The aperture has “a first portion for cooperation with the first fastener to provide dynamic fixation” and “a second portion extending from and connected to the first portion for cooperation with the second fastener to provide static fixation.” The edge continues around and defines both portions of the aperture. Claim 21 also provides that the first fastener is secured in the first portion if dynamic fixation is chosen and the second fastener if secured in the second portion if static fixation is chosen. As discussed above, it appears that the Examiner is interpreting elements 17 and 22 in Border to comprise portions of an aperture. However, elements 22 are not seen to extend from or connect to element 17 in Border. Elements 17 and 22 are defined by separate and distinct edges; the edge that defines element 17 does not continue around the elements 22. Accordingly, claim 21 is patentable over Borden.

Independent claim 22 is directed to a kit for use in orthopaedic surgery. The kit includes three fasteners and an intramedullary nail. The nail has a body with two ends and an edge defining an aperture. The edge is spaced from the ends of the body and has a curved portion and opposed straight portions. The curved portion of the edge extends for more than 180 degrees. The aperture has an enlarged portion along the curved edge and a constricted portion adjacent and connected to the enlarged portion. The diameter of the enlarged portion is greater than the distance between the two opposing parts of the edge defining the constricted portion of the aperture. Border does not disclose such an aperture. Therefore, claim 22 and its dependent claims 23-31 are believed to be allowable over the prior art.

### 35 U.S.C. §103

Dependent claims 7, 9, 17, 28, and 30 were rejected under 35 U.S.C. §103 as being unpatentable over Border in view of U.S. Patent 5,814,047 to Emilio et al. (“Emilio”). Dependent claims 7 and 9 depend from claim 1 and therefore include the limitations of a nail with a continuous edge defining an aperture, the edge having curved parts and opposed straight parts defining two cylindrical end portions and a first portion positioned between the cylindrical end portions, with the widths of the cylindrical end portions being greater than the distance between the opposed straight parts of the edge. As discussed above, in reference to claim 1, Border does not disclose this feature. Emilio also does not disclose this feature. Emilio is directed to a nail having “a plurality of equilaterally spaced piercing points and a plurality of flexible screws.” Abstract. There is no disclosure in Emilio of a single aperture that is shaped as set forth in claim 1. Therefore, dependent claims 7 and 9 are believed to be allowable over the combination of Border and Emilio.

Claim 17 is dependent on claim 11, and therefore, includes the limitations of an edge that is spaced from the two ends of the body and includes substantially parallel parts defining a first portion of the aperture sized and shaped to cooperate with said first fastener to provide dynamic fixation, a second curved part extending from and connected to the first substantially parallel parts, defining a curved portion of the aperture that is sized and shaped to cooperate with said second fastener to provide either static fixation or dynamic fixation, the curved portion of the aperture having a width greater than the distance between the substantially parallel parts of the edge defining the first portion of the aperture. Neither Border nor Emilio disclose this limitation. For at least this reason, Claim 17 is believed to be allowable.

Claims 28 and 30 are dependent on claim 22, and include the limitations of an edge spaced from the ends of the body and having a curved part and opposed straight parts, the edge defining an aperture with an enlarged portion along the curved edge and a

constricted portion adjacent and connected to the enlarged portion, the diameter of the enlarged portion being greater than the distance between the two opposing parts of the edge defining the constricted portion of the aperture. Because neither Border nor Emilio disclose this limitation, claims 28 and 30 are believed to be allowable.

### **Conclusion**

For the above-described reasons it is respectfully submitted that the rejections to the claims have been overcome and that all remaining claims, namely claims 1-5 and 7-32 are currently in condition for allowance. A Notice of Allowance is respectfully requested.

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